



Document No.: 192400US55X

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/675,180
Applicants: David SUDA, et al.
Filing Date: September 29, 2000
For: BACKING SHEET, AND SYSTEM
AND METHOD OF FABRICATION
THEREOF
Group Art Unit: 1745
Examiner: RHEE, J. J.

SIR:

Attached hereto for filing are the following papers:

REPLY BRIEF

In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Jean-Paul Lavalleye

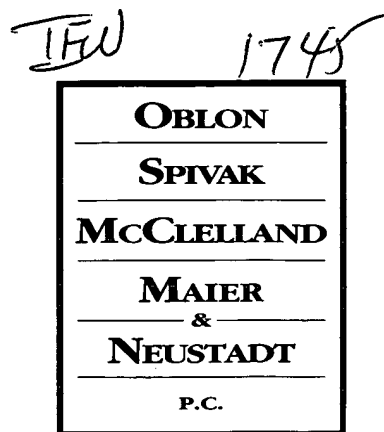
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DOCKET NO.: 192400US55X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
David SUDA, et al. : EXAMINER: RHEE, J. J.
SERIAL NO: 09/675,180 :
FILED: September 29, 2000 : GROUP ART UNIT: 1745
FOR: BACKING SHEET, AND :
SYSTEM AND METHOD :
OF FABRICATION THEREOF :

REPLY BRIEF UNDER 37 C.F.R. §41.41

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply to the Examiner's Answer mailed April 4, 2006. An Appeal Brief was timely filed on January 20, 2006.

REPLY TO EXAMINER'S ANSWER

The Examiner's Answer acknowledges that the Arakawa et al. invention fails "to disclose at least one hole that bonds the first portion of the back side to the second portion of the back side wherein the hole extends through the backing sheet such that a portion of the adherent material extends through at least one hole and contacts the back side." (Last two lines of page 5, through page 6, line 2.) However, the Examiner's Answer argues that such features are indicated as being known in the art based on the background discussion in column 1, lines 37-39, of Arakawa et al. (Page 6, lines 12.) The Examiner's Answer further indicates that while Arakawa et al. teaches preferred embodiments that do not include a hole

as recited in the claims of the present application, the rejection is based on teachings in Arakawa et al. of a broader disclosure or non-preferred embodiments. (Page 6, line 13, through page 7, line 10.)

The Appellants respectfully submit that the rejection is not based on a *non-preferred embodiment* of the invention of Arakawa et al. The rejection is not being based on a non-preferred embodiment of the invention of Arakawa et al. (note that all of the disclosed embodiments of Arakawa et al. are specifically missing such a hole, for reasons that will be discussed in more detail below), but rather the rejection is being based on a background discussion of a published Japanese patent application, namely JP-B-58-30401. Such a rejection is, in many respects, equivalent to the citation of a secondary reference. As noted in MPEP 2143, there must be some suggestion or motivation to modify the reference or to combine reference teachings. The Appellants submit that such a motivation is lacking in the present rejection.

MPEP 2143.01 I. notes that the prior art must *suggest the desirability* of the claimed invention. This section of the MPEP states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some *teaching, suggestion, or motivation to do so....*” (Emphasis added.) Not only does the teaching of Arakawa et al. fail to provide a teaching, suggestion, or motivation to include a hole as claimed in the embodiments of the invention described therein, but it expressly criticizes, discredits, and otherwise discourages the use of such a hole. (*See, generally, In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004).) Arakawa et al. does not suggest the desirability of the claimed invention.

As noted in the Appeal Brief, Arakawa et al. states that “*since in the foregoing pressure-sensitive adhesive tape, the 1st leg (c) is stuck to the 3rd leg (a) with an adhesive by forming a penetrated hole at the central portion of the 2nd leg (b) portion, there are problems that the adhesive is exuded through such a penetrated hole to make rewinding impossible and the tape becomes sticky to use to give an unpleasant feeling to the customer.*” (Column, 1, lines 36-42, emphasis added.) Thus, Arakawa et al. teaches away from the use of such a hole and clearly criticizes, discredits, and otherwise discourages such a solution, due to the problems annunciated in the quotation above. Arakawa et al. then expressly states that “[t]he present invention has been made for solving the problems in the conventional techniques described above” (column 1, lines 56-57), and thus teaches a configuration for an adhesive tape that does not include such a hole and therefore does not have the annunciated problems specific to absorptive articles that are worn by people, which are the concern of Arakawa et al. Clearly, Arakawa et al. does not in any manner suggest the desirability of the proposed combination.

As noted in MPEP 2141.02, the references must be considered in their entirety, *including the disclosures that teach away from the claims.* Thus, the portion of Arakawa et al. that teaches away from the inclusion of such a hole cannot be overlooked.

Accordingly, no motivation existed to modify the invention described in Arakawa et al. to arrive at the present invention recited in Claim 19.

For the reasons set forth in detail above and in the Appeal Brief, the Appellants submit that a *prima facie* case of obviousness has not been established in the present case, and therefore request that the obviousness rejection of Claim 19 based on Arakawa et al. be

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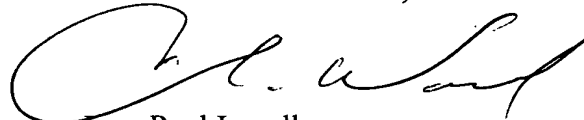
reversed.

Claims 20, 32, and 33 are considered allowable for at least the reasons advanced for Claim 19 from which they depend. Therefore, the Appellants request that the obviousness rejections of Claims 20, 32, and 33 based on Arakawa et al. be reversed.

The Appellants therefore respectfully submit that all of the pending claims are patentable, and so requests that the final rejection be REVERSED.

Respectfully submitted,

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